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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/295,826	04/21/1999	TODD R. COLLART	IACP007	7629

22887 7590 07/17/2003

DISCOVISION ASSOCIATES
INTELLECTUAL PROPERTY DEVELOPMENT
2355 MAIN STREET, SUITE 200
IRVINE, CA 92614

EXAMINER

WINTER, JOHN M

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 07/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/295,826

Applicant(s)

COLLART, TODD R.

Examiner

John M Winter

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>19</u> | 6) <input type="checkbox"/> Other: |

Art Unit: 3621

DETAILED ACTION

Status

Claims 1-20 are presently pending

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Response to Arguments

The applicants arguments filed on May 6, 2003 have been fully considered but are not persuasive.

The applicant states that the Gracenote, Archibald and Oshima references do not the feature of combining of a logic and an identifier to trigger transaction for a payment.

The Examiner states that this feature is disclosed by the newly discovered reference Hellman (US Patent 4,658,093). See following rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6,8,10,11-16,18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gracenote.com (New Media pioneers Ann Greenberg and Ty Roberts join CDDDB.Com) in view of Archibald et al. (US Patent 5,825,883) and in further view of Hellman (US Patent 4,658,093).

As per claim 1,
Gracenote.com discloses a method for permitting selective access to data based on an identifier stored on an electronic storage medium, comprising the steps of reading the identifier of the electronic storage medium;(Gracenote.com, paragraph 7)

Art Unit: 3621

verifying the identifier in a separate database; (Gracernote.com, paragraph 7)

Gracernote.com does not explicitly disclose collecting a payment for use of content on the electronic storage medium Archibald et al. ('883) discloses collecting a payment for use of content on the electronic storage medium. (figure 14) It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Gracernote.com method with the Archibald et al method in order to collect a payment for use of content on the electronic storage medium in order to reduce the amount of revenue lost because of rampant piracy of digital materials.

Gracernote.com does not explicitly disclose combining a logic with the identifier to trigger a transaction for the payment. Hellman. ('093) discloses combining a logic with the identifier to trigger a transaction for the payment. (Figure 5 –shows billing , also Column 10, lines 33-65 – shows trigger logic) It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Gracernote.com method with the Hellman method in order to collect a payment for use of content on the electronic storage medium in order to reduce the amount of revenue lost because of rampant piracy of digital materials.

Claim 11 is in parallel with claim 1.

As per claim 2,

Gracernote.com discloses the method as recited in claim 1,
wherein the identifier is verified in the separate database after the user effects a remote link between the computer and the separate database. (Gracernote.com, paragraph 7)

Claim 12 is in parallel with claim 2.

As per claim 3,

Gracernote.com discloses the method as recited in claim 1,
Gracernote.com does not explicitly disclose wherein logic tailors video based information. Archibald et al. ('883) discloses wherein logic tailors video based information (column 6, lines 33-47) It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Gracernote.com method with the Archibald et al method of combining identifier information associated with the identifier and user information associated with the user in order to simplify record keeping procedures by merging customer and transaction data.

Claim 13 is in parallel with claim 3.

As per claim 4,

Gracernote.com discloses the method as recited in claim 1,
Gracernote.com does not explicitly disclose storing a record of the transaction in a database. Archibald et al. ('883) discloses storing a record of the transaction in a database (column 6, lines 48-59; also figure 3) It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Gracernote.com method with the

Art Unit: 3621

Archibald et al method of storing a record of the transaction in a database in order to simplify record keeping procedures.

Claim 14 is in parallel with claim 4.

As per claim 5,
Gracernote.com discloses the method as recited in claim 1,
wherein the computer is remotely coupled to the separate database via a network.
(Gracernote.com, paragraph 7)

Claim 15 is in parallel with claim 5.

As per claim 6,
Gracernote.com discloses the method as recited in claim 5.
Gracernote.com does not explicitly disclose the payment processing is conducted electronically in a secure manner. Archibald et al. ('883) discloses the payment processing is conducted electronically in a secure manner. (column 6, lines 48-67) It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Gracernote.com method with the Archibald et al method of processing payments in a secure manner in order to promote consumer confidence by protecting sensitive account information.

Claim 16 is in parallel with claim 6.

As per claim 8,
Gracernote.com discloses the method in claim 1.
wherein electronic storage medium is an optical disc.(Gracernote.com, paragraph 7)

Claim 18 is in parallel with claim 8.

As per claim 10,
Gracernote.com discloses the method in claim 1,
wherein the data is stored in a remote database.(Gracernote.com, paragraph 7)

Claim 20 is in parallel with claim 10.

Claims 7,9,17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gracernote.com (New Media pioneers Ann Greenberg and Ty Roberts join CDDDB.Com) in view of Archibald et al. (US Patent 5,825,883) and further in view of Oshima et al (US Patent 6,081,785) and in further view of Hellman (US Patent 4,658,093).

As per claim 7,
Gracernote.com discloses the method as recited in claim 5,

Art Unit: 3621

Gracernote.com does not explicitly disclose an electronic code is utilized to authorize use of the content on the electronic storage medium. Oshima et al ('785) discloses an electronic code is utilized to authorize use of the content on the electronic storage medium. (Figure 24b) It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Gracernote.com method with the Oshima et al ('785) method of using an electronic code to authorize use of content on an electronic storage medium in order prevent piracy of digital materials.

Claim 17 is in parallel with claim 7.

As per claim 9,

Gracernote.com discloses the method as recited in claim 8.

Gracernote.com does not explicitly disclose the identifier is stored on a burst cut area of the optical disc. Oshima et al ('785) discloses the identifier is stored on a burst cut area of the optical disc. (column 1, lines 36-50; also figure 18) It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Gracernote.com method with the Oshima et al ('785) method of storing an identifier on a burst cut area of the optical in order prevent piracy of digital materials.

Claim 19 is in parallel with claim 9.

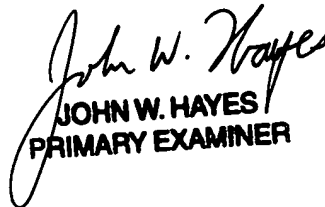
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M Winter whose telephone number is (703) 305-3971. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P Trammell can be reached on (703) 305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

JMW
July 10, 2003


JOHN W. HAYES
PRIMARY EXAMINER